

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Takuhito UENO et al.

Application No.: 09/975,250

Examiner: RUDOLPH

Filed: October 12, 2001

Docket No.: 110863

For: PRINTING SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby request review of the rejections set forth in the May 1, 2007 Office Action. A Notice of Appeal and fee in the amount of \$500 are filed concurrently herewith.

I. Status of Pending Claims

Claims 16-25 are pending in this application. Claims 16-25 are rejected. Claim 16 is the only independent claim. No amendments are being filed with this request.

II. Grounds of Rejection Presented For Review

The following grounds of rejection are presented for review:

(A) the rejection of claims 16-19 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,542,253 ("Kim") in view of U.S. Patent No. 6,084,934 ("Garcia"), further in view of U.S. Patent No. 6,742,130 ("Kawase"), further in view of U.S. Patent No. 6,594,027 ("Guillemin");

(B) the rejection of claim 20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Kim in view of Garcia, further in view of Kawase, further in view of Guillemin, and further in view of U.S. Patent No. 6,977,945 ("Noda");

(C) the rejection of claims 22-23 under 35 U.S.C. §103(a) as allegedly being unpatentable over Kim in view of Garcia, further in view of Kawase, further in view of Guillemín and allegedly commonly known prior art at the time of the invention; and

(D) the rejection of claims 21, 24 and 25 under 35 U.S.C. §103(a) as allegedly being unpatentable over Kim in view of Garcia, further in view of Kawase, further in view of Guillemín, further in view of Noda and allegedly commonly known prior art at the time of the invention.

A. Kim and Guillemín

With respect to claim 16, the Patent Office alleges that Kim teaches an image forming apparatus having a power save mode and a normal mode. The Patent Office concedes that Kim does not teach or suggest the image forming apparatus including a controller configured to be in the off-state in the power save mode and to control the image forming portion to output the received data after a period of transition from the power save mode to the normal mode, and relies on Guillemín as allegedly teaching this feature.

However, the combination of Kim and Guillemín fails to teach or suggest that a controller is in an off-mode during a power save mode. Guillemín is directed toward a method of identifying the location of interchangeable media handling devices relative to one another and relative to an image-forming device (see column 1, lines 10-13). Nowhere does Guillemín teach or suggest a controller configured to be in an off-state in a power save mode. Guillemín merely discloses that media handling devices may be in a sleep mode, a power save mode, or an off mode (see column 1, lines 37-39).

Not only does Guillemín fail to disclose a controller configured to be in an off-state in a power save mode, Guillemín fails to disclose a controller at all. Guillemín generally discloses "media handling devices." However, even if the controller of claim 16 is considered to be a media handling device as disclosed in Guillemín, nowhere does Guillemín teach or

suggest that a media handling device is in an off-state in a power save mode. Guillemín only discloses that the media handling devices may be in a sleep mode, a power save mode, or an off mode.

Thus, while it appears as though the Patent Office is only relying on Guillemín to teach that a media handling device (alleged controller) can be in an off-state, claim 16 requires more than a controller being configured to be in an off-state. Claim 16 requires a controller configured to be in an off-state in a power save mode, and nowhere does Guillemín teach or suggest both of these required features.

B. Garcia and Kawase

In addition to the above, claim 16 is further distinguished by the use of an interface that includes a receiver, and is configured to control a speed for receiving data during the period of transition from the power save mode to the normal mode.

The Office Action asserts that the combination of Garcia and Kawase teaches this feature. However, none of the applied references, alone or in combination, teach or suggest an image forming apparatus having an interface that includes a receiver, and is configured to control a speed for receiving data during the period of transition from the power save mode to the normal mode.

It appears as though the Patent Office is relying on Kawase for teaching a power save mode and Garcia for teaching controlling the rate at which data is received. However, it is evident that the Patent Office is improperly picking and choosing various elements of the claims from the prior art in hindsight, and ignoring the requirements recited in the present claims with respect to how the elements interact.

That is, Garcia is directed to a data transmission system capable of automatically adjusting a data transfer rate of a sender to a receiver and Kawase is directed to an interface apparatus having a power-saving function. However, the interface apparatus of Kawase does

not receive data when the interface apparatus is in a power-saving state (see column 3, lines 21-28). Therefore, even if the Kawase and Garcia were to have been combined, the combination merely provides an interface apparatus that controls the rate at which data is received when the interface apparatus is not in a power save mode.

In contrast, claim 16 requires a receiver configured to control a speed for receiving data during the period of transition from the power save mode to the normal mode. That is, the receiver begins receiving data in the power save mode and controls the speed of receiving this data until at least a normal mode is reached. Therefore, as claim 16 requires a receiver to receive data in a power save mode, and Kawase teaches away from receiving data in a power save mode, one of ordinary skill in the art would not have been motivated to have combined the teachings of Kawase with that of Garcia to achieve the features of claim 16, or to have been able to have derived the image forming such teachings.

C. Noda and Alleged Commonly Known Prior Art

Noda teaches a data transmission system and a network interface for controlling a transfer rate in response to notices informing that reception is normally completed or not normally completed. However, Noda fails to cure the deficiencies of Kim, Garcia, Kawase and Guillemmin, detailed above, in disclosing or rendering obvious the features of independent claim 16.

Furthermore, the allegedly commonly known prior art fails to cure the above-detailed deficiencies of Kim, Garcia, Kawase and Guillemmin in disclosing or rendering obvious the features of independent claim 16.

III. Conclusion

For all of the reasons discussed above, it is respectfully submitted that the rejections are factually in error, that as such the rejections are legally insufficient to establish a proper prima facie case of obviousness, and that in view of these errors, the pending claims are in condition for allowance. For all of the above reasons, Applicants respectfully request the panel of Examiners to review the rejections in the January 27, 2006 Office Action prior to Appeal, and to withdraw these rejections.

Respectfully submitted,



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